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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Confirmation No. 6544
Benoit PUGIN et al. : Attorney Docket No. 2005_1466A
Serial No. 10/552,066 : Group Art Unit 1621
Filed October 5, 2005 : Examiner Sudhakar Katakam
AMINE-SUBSTITUTED
DIPHENYLDIPHOSPHINES : Mail Stop: Amendment

RESPONSE TO REQUIREMENT FOR RESTRICTION
AND ELECTION OF SPECIES

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEE FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975.

Sir:

This is responsive to the Office Action of August 20, 2008 constituting a requirement for restriction and election of species.

Applicants initially note that the Examiner had previously required restriction and election of species, in the Office Action of April 2, 2008. Applicants filed a response to that Office Action on May 2, 2008, traversing the requirement.

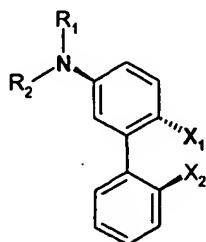
As noted by the Examiner in item 8 on page 7 of the current Office Action, the Examiner called Applicants' attorney on August 11, 2008, asking Applicants' attorney (in accordance with a discussion the Examiner had with his supervisor) to limit the claims to the elected species of compounds 29 and 30, which the Examiner said are allowable. Applicants' attorney indicated that the Examiner needed to do a search of the prior art until he finds a reference which discloses a compound that anticipates or suggests a compound within the scope of the claims elected in response to the earlier Restriction Requirement, i.e. claims 1-5 and 7-8. The Examiner indicated that he would discuss this with his supervisor. Apparently after talking to his supervisor, the Examiner called Applicants' attorney (voice mail) and indicated that a search of the entire scope of claim 1 would be too much of a burden, and that further restriction was necessary based on

claim 5. Applicants' attorney then left a voice mail for the Examiner asking him to issue an Office Action setting forth the basis for a further restriction requirement.

Referring to item 1 on page 2 of the current Office Action, after acknowledging Applicants' earlier response to the restriction requirement, the Examiner states that "upon further consideration" the new restriction requirement has been applied. But the reasons set forth by the Examiner for restriction in the current Office Action are the same as in the earlier Office Action. If the further consideration referred to by the Examiner means that a search of the entire scope of claim 1 would be too much of a burden, as indicated during the telephone discussion with the Examiner, then Applicants respectfully submit that this is not sufficient grounds by itself to warrant a restriction requirement. The Examiner states that there is lack of unity of invention, which is the same basis upon which restriction was required in the earlier Office Action. Applicants have previously argued that there is unity of invention, and those arguments are still applicable to the current restriction requirement, and are incorporated herein, summarized below.

1. The claims were considered as new and inventive in the International phase.

The **common technical feature** is the diphosphine, characterized with the features: a) X1 and X2 are **secondary phosphine groups**, which b) are bound to a **biphenyl backbone**, and whereby c) the secondary phosphine groups are in **1,1'-position**, and d) the backbone bearing at least **amino group in para-position** to the secondary phosphine group:



2. The PCT-IPER did not raise an "a priori" non-unity objection (an "a posteriori" objection was ruled out as the invention was considered new in view of the prior art).

3. The Examiner nevertheless surprisingly raised an "a priori" non-unity objection.

4. PCT Rule 13.2 requires that the technical features define a **contribution over the prior art for each of the inventions** and thus providing the single inventive concept as required by Rule 13.1.

5. So far the Examiner has not presented any arguments as to why the given groups do not provide a contribution over the prior art according to PCT Rule 13.2. The arguments

under point 3 of the current Office Action are not proper. According to the PCT-guidelines (Example 1 below), unity is given, which is applicable for the instant application:

"Claims in Different Categories

10.21 Example 1

Claim 1: A method of manufacturing chemical substance X.

Claim 2: Substance X.

Claim 3: The (method of) use of substance X as an insecticide.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is substance X (in the instant case the diphosphine characterized above). However, if substance X is known in the art, unity would be lacking because there would not be a special technical feature common to all the claims."

Re reason (i) given by the Examiner in item 3 of the current Office Action, as Applicants mentioned in responding to the earlier restriction requirement, according to the PCT-guidelines it is permitted, in addition to an independent claim for a given product, to have an independent claim for a process specifically adapted for the manufacture of the product, whereby the words "specially adapted" are not intended to imply that the product could not also be manufactured by a different process.

Re reason (ii): All groups do have in common the same technical feature, namely the diphosphines as characterized under point 1 above. The Examiner must provide the necessary novelty destroying prior art documents to support the restriction requirement. However, so far the Examiner has not cited any prior art to support lack of unity of invention, as a result of which Applicants again respectfully submit that the restriction requirement should be withdrawn.

In order to be completely responsive to the current Office Action, Applicants elect, with traverse, the Group IV subject matter identified by the Examiner on page 3 of the Office Action. As a species, Applicants elect compound 29, which was the species elected in response to the earlier Office Action. As noted in the earlier Office Action, Applicants request that the Examiner also examine compound 30 on page 55. Both compounds are the same, except having different stereochemistry; and they were made using different preparation routes. Compound 29 falls under general formula (la) of claim 1, while compound 30 falls under general formula (lb) of claim 1.

The claims which read on the elected species are claims 1, 2, 4 and 5.

Compounds 29 and 30 read on claim 1 where:

R₂ and R₃ is C₁-C₄-alkylene,

R₁ is C₁-C₈-alkyl,

R₅ is a R₃-O-group,

R₆ is a R₁R₂N-group, thus R₅ and R₆ together are as R₂ and R₃ together, and

R₄ and R₇ are hydrogen.

Compounds 29 and 30 are also covered by claims 2, 4 and 5 (formula 1e).

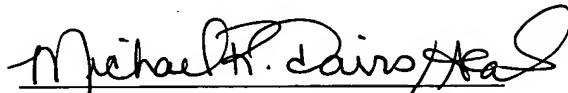
Applicants again emphasize that the foregoing elections are made with traverse, based on the arguments set forth above. Consistent with this traversal, the foregoing elections are made while reserving Applicants' rights under 35 U.S.C. §121 to file a divisional application for the non-elected subject matter.

Action on the merits is requested.

Respectfully submitted,

Benoit PUGIN et al.

For:

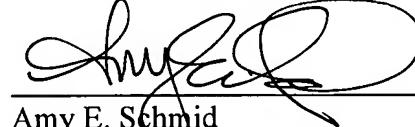


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